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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,491	07/13/2004	Bert C Wong	AD6843USPCT	8281

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E I du Pont de Nemours & Company
Legal Patents
Wilmington, DE 19898

EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/501,491	Applicant(s) WONG ET AL.	
	Examiner William K. Cheung	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The instant application is revived in view of the petition filed February 6, 2006.
2. In view of amendment filed February 6, 2006, the rejection of Claims 13-19 are rejected under 35 U.S.C. 112, second paragraph, is withdrawn.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/501,493. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed plasticized PVB

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composition is seen to have the same components as identified in the claim 1 of the copending application. The claim of the copending application cites a small laminate article comprising a plasticized PVB resin. Given the overlap in scope, the instantly claimed invention is rendered *prima facie* obvious by the claim of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 21 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/501,598. The difference between the subject matter of present Claim 21 and Claim 1 of the copending application is extrusion temperature and PVB sheet's glass transition temperature, T_g . A comparison is shown in the following table.

	The instantly claimed	Copending Application
Extruding Temperature °C	225 - 245	175 - 225
T_g °C	35 - 60	> 32

As one can see, the copending ranges overlap the instantly claimed ones. It has been consistently held that even a slight overlap in range establishes a *prima facie* case of obviousness. *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Degeilh et al. (U.S. Patent 5,187,217) for the reasons adequately set forth from paragraph 8 of the non-final office of June 16, 2005.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 2-3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Degeilh et al. as applied to claim 1 above, and further in view of Garrett et al. (US Patent Pub: 2002/0182422), for the reasons adequately set forth from paragraph 11 of the non-final office of June 16, 2005.

10. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Degeilh et al. as applied to claim 1 above, in view of Garrett et al. as applied to claims 2-3, and further in view of Gutweiler (US Patent 5,573,842), for the reasons adequately set forth from paragraph 12 of the non-final office of June 16, 2005.

11. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Degeilh et al. as applied to claim 1 above, in view of Garrett et al. as applied to claims 2-3, further in view of Gutweiler (US Patent 5,573,842) as applied to claims 4-6, and yet still further in view of Shohi et al. (EP-1036775 A1) and online Product Catalog from Great Lakes Chemical Corporation, www.pa.greatlakes.com, 3rd Edition, October 2001, for the reasons adequately set forth from paragraph 13 of the non-final office of June 16, 2005.

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12. Claims 1 and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutweiler (US Patent 5,573,842) in view of Shohi et al. (EP-1036775 A1), for the reasons adequately set forth from paragraph 14 of the non-final office of June 16, 2005.

13. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gutweiler (US Patent 5,573,842) in view of Dauvergne (FR Patent 2,401,941), and further in view of Shohi et al. (EP-1036775 A1), for the reasons adequately set forth from paragraph 15 of the non-final office of June 16, 2005.

Response to Arguments

14. Applicant's arguments filed February 6, 2006 have been fully considered but they are not persuasive.

Applicants argue that the instantly claimed invention contains a surfactant while Degeilh et al. do not. However, applicants fail to recognize that the claims as written "less than about 30 pph" does not exclude composition without surfactant because zero is still less than 30 pph.

Regarding applicants' argument on the differences between a bleach and an optical brightener, such argument is only valid if applicants' specification provides a

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disclosure to point out the differences between a bleach and an optical brightener.

According to applicants' specification (page 6), the recitation "A PVB bleaching compound of the present invention is any compound that can reduce or eliminate color from a PVB sheet relative to the color of an otherwise identical composition" is silent on how the color values are detected. Therefore, in the case of lack of disclosure, the examiner has the right to use the broadest interpretation of the recited "bleaching" during the examination. Since color are properties that are perceived by individuals, if the addition of blue to flush out yellow can reduce the perception of yellow, the rejection set forth by the examiner is proper. Applicants must recognize that when critical terminology is not properly disclosed, one of ordinary skill in art would also use the broadest interpretation when reading a claim.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

April 18, 2006

**WILLIAM K. CHEUNG
PRIMARY EXAMINER**